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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316

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EXAMINER

NGUYEN, NGHIA D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,408

Applicant(s)

BROWN, CHARLES P.

Examiner

Patrick D. Nguyen

Art Unit

3629

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/6B/98)
Paper No(s)/Mail Date 11/22/04, 12/23/04, 3/09/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The U.S department of commerce, working under the authority of the Congress, is under contract with ICANN for the domain name registration, and therefore has no authority to grant a patent to a system that they have no jurisdiction over. In the memorandum of Understanding between Dept of Commerce and ICANN it states that ICANN business purpose is

- i) coordinate the assignment of Internet technical parameters as needed to maintain universal connectivity on the Internet
- ii) perform and oversee functions related to the coordination of the Internet Protocol (IP) address space
- iii) perform and oversee functions related to the coordination of the Internet domain name system including the development of policies for determining the circumstances under which new top level domains names are added to the DNS root system.

Claim 1-33 are rejected on ground that they infringe on U.S laws set forth by Congress.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1-13 and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or APPA) or Mann et al (U.S. patent No. 6,519, 589) in view of KORITZINSKY et al (U.S. patent No.6272469) in view of Hagan (U.S. patent No.6415267)

As for claim 1, AAPA fairly disclose the method of registration is well known .
Accepting information from a public domain name registrar is necessary for any domain name registration system. Also, Mann et al teaches a method of obtaining information (plurality of names) from a public domain name registrar database for domain name registration (See Abstract). Mann discloses the invention except for :

Method of payment the fee or payment for service used (in this case, registration of domain name) i.e. accepting a one-time registration payment fee that can be used to perpetually pay for all future renewal fees for domain name registration instead of paying annually or pay-per-use.

KORITZINSKY et al is cited to teach the general concept of paying for a subscribed service such as (a) pay per use, (b) annually (c) periodically, or (d) permanently for the benefit of lifetime service or non-expiring warranty service with one-time payment of fee (one-time fee service) {see column 21, lines 16-31, col.22 lines 50-58}. It would have been obvious to modify the fee payment process of Mann et al by using option (d) or one-time payment of fee(one time fee service) as taught by KORITZINSKY et al for the benefit cited above, which is lifetime service or non-expiring warranty services. As for the limitation of "a permanent registration certificate", Mann et al would normally issue a registration certificate based on the type of payment of fee, and since this is in combination of KORITZINSKY et al , the issuance of a permanent registration certificate is inherently included or would have been obvious to a skilled artisan to do so if desired.

As for Claim 2, a computer medium (i.e. ram or any storage device) is inherently needed to store registration instruction.

As for Claim 3, a permanent registration certificate is inherently needed for receipt or proof or registration & purchase if a permanent registration took place and reference to claim 2, its inherent the information need a place to be store (i.e. database)

As for Claim 4, KORITZINSKY et al teaches a lifetime subscription warranty on the registration certificate (Column 21, paragraph 2, line 20). Warranty is an insurance that cover financial losses with not properly renewing.

As for Claim 5, issuing title to show a lifetime service/ ownership is a well know and concept, and it would be obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 6, issuing a plurality of shares is a well-known concept, corporation can sell shares to public to own, and invest in their company. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 7, issuing leases or subleases is a well known concept (i.e. house leasing, car leasing, anything can be leases, including domain names at sites like <http://allfordomains.com/rent.asp/>) It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 8, it is well known that you can have co-ownership of a property (joint-title, joint tenant ownership). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 9, issuing an email certificate is well-known and obvious routine for online registration procedure. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 10, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 11, Hagan discloses investing in a financial program to generate fund (i.e. interest bearing accounts, mutual funds, stocks, bonds). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 12, KORITZINSKY et al disclose accepting a one-time permanent registration fee. It is well known and obvious that an electronic fee is necessary since registration is taking place over the Internet. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 13, if registration fee doesn't take place over the Internet than it would be obvious to use U.S postal mail.

Claims 14-18 are rejected under 35. U.S.C 103(a) as being unpatentable over Schneider (U.S. patent No.6901, 436) in view of KORITZINSKY et al.

As for claim 14, Schneider teaches a method, product, and apparatus for requesting a network resource (see Abstract, line 1-7), in which he teaches displaying query results for the plurality of domain names register in the domain registration system. Schneider teaching does not include: determine the renewal fee, paying the renewal fee, transferring additional renewal fee to maintain the right of the domain name. However, KORITZINSKY et al (Abstract, line 1-8) teaches a method of determining, paying and verifying current and future renewal fee for registration subscription. (Column 23, line 5-15) Motivation to combine the teaching of Schneider with KORITZINSKY et al is to have automatic renewal system for domain name.

As for Claim 15, a computer medium (i.e. ram or any storage device) is inherently needed to store registration instruction.

As for Claim 16-18, KORITZINSKY et al teaches a method of renewal registration subscription including generating a listing of current registration holder (Column 19, line 10) and notifying personnel or renewal information (Column 24 line, 24-25)

Claim 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or APPA) or Mann et al (U.S. patent No. 6,519, 589) in view of KORITZINSKY et al (U.S. patent No.6272469) in view of Hagan (U.S. patent No.6415267).

As for claim 19, 20, 23, 24. AAPA in view of KORITZINSKY et al disclose of method of Claim 1. Furthermore its obvious that any domain name registration system needs a web host to host the system and this web host have access to database to store instruction.

As for Claim 21 & 22, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 25, AAPA in view of KORITZINSKY et al disclose of method of Claim 1. Furthermore its obvious that any domain name registration system needs a web host to host the system and this web host have access to database to store instruction over a server because the nature of the system is dependent on being "online" . It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 26, it obvious that a online registration system would need a computer medium, database, and connect over a server to work. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 27, it is well known that you can have co-ownership of a property (joint-title, joint tenant ownership). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 28, issuing leases or subleases is a well known concept (i.e. house leasing, car leasing, anything can be leases, including domain names at sites like <http://allfordomains.com/rent.asp/>) It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 29, Furthermore co-use of a permanent registration of a domain name is obvious. A domain name for corporation (i.e. I.B.M) is used by many individual. Claim 29 refers to subdomain or secondary URL, in requesting for protocol address, a well-known concept. (i.e. www.permanent.com/john , www.permanent.com/bob/)

As for Claim 30-34, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant these component into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service benefit/guarantee as taught by KORITZINSKY et al and in further view of Hagan. It is obvious that a online registration system would need a computer medium, database, and connect over a server to work. It would have been obvious to implant these component into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

All Claims are rejected

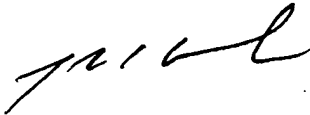
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Nguyen whose telephone number is 7038395713. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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